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# In the Supreme Court of the United States

OCTOBER TERM, 1957

FREDERICK C. BERSWORTH AND THE DOW CHEMICAL COMPANY, PETITIONERS

*v.*

ROBERT C. WATSON, COMMISSIONER OF PATENTS

*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT*

## BRIEF FOR THE RESPONDENT IN OPPOSITION

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# INDEX


| | Page |
|---|---|
| Opinions below | 1 |
| Jurisdiction | 2 |
| Question presented | 2 |
| Statutes | 2 |
| Statement | 3 |
| Argument | 7 |
| Conclusion | 15 |


## CITATIONS


Cases:

| | |
|---|---|
| *Asseff, et al.* v. *Marzall*, 189 F. 2d 660 | 9 |
| *Chemical Foundation* v. *General Aniline Works*, 99 F. 2d 276 | 14 |
| *Collins, In re*, 22 C. C. P. A. 1053, 75 F. 2d 1000 | 10 |
| *Cramp & Sons* v. *Curtis Turbine Co.*, 246 U. S. 28 | 14 |
| *Crowell, In re*, 23 C. C. P. A. 1246, 84 F. 2d 206 | 10 |
| *Duryea* v. *Rice*, 28 App. D. C. 423 | 11 |
| *Febrey, In re*, 30 C. C. P. A. 1099, 135 F. 2d 751 | 11 |
| *Field* v. *Celman*, 40 App. D. C. 598 | 11 |
| *Forward Process Co.* v. *Coe*, 116 F. 2d 946 | 12 |
| *General Electric Co.* v. *Continental Fibre Co.*, 256 Fed. 660 | 11 |
| *General Railway Signal Co.* v. *Thullen*, 32 App. D. C. 575 | 10 |
| *Godfrey* v. *Eames*, 1 Wall. 317 | 11 |
| *Good Roads Co.* v. *Chas. Hvass & Co.*, 70 F. 2d 625 | 11 |
| *Interchemical Corporation* v. *Watson*, 251 F. 2d 390 | 16 |
| *Klein, In re*, 1930 Commissioners' Decisions 2 | 11 |
| *Kropa* v. *Robie, et al.*, 38 C. C. P. A. 858, 187 F. 2d 150 | 12 |
| *Lindley* v. *Shepherd*, 24 F. 2d 606 | 12 |
| *McCormick* v. *Malherbe*, 28 C. C. P. A. 838, 116 F. 2d 520 | 12 |
| *McCormick Machine Co.* v. *Aultman*, 169 U. S. 606 | 14 |
| *Moist Cold Refrigerator Co.* v. *Lou Johnson Co., Inc.*, 249 F. 2d 246 | 16 |

Cases—Continued Page

*Mraz, In re*, 36 App. D. C. 435 ..... 10
*Mullins Manufacturing Co.* v. *Booth*, 125 F. 2d 660 .. 14
*Petrocarbon Limited* v. *Watson*, No. 711, this Term, certiorari denied, 355 U. S. 955 ..... 15
*Prutton, Application of*, 40 C. C. P. A. 724, 200 F. 2d 706 ..... 10
*Smyth, Application of*, 38 C. C. P. A. 1130, 189 F. 2d 982 ..... 10
*Stradar* v. *Watson*, 244 F. 2d 737 ..... 14
*Thompson* v. *Dicke*, 27 C. C. P. A. 931, 110 F. 2d 98 . 10
*Van der Horst Corp. of America* v. *Chromium Corp. of America*, 98 F. Supp. 412 ..... 12

Constitution and Statutes:

Constitution of the United States, Art. I, Section 8, Clause 8 ..... 10
Act of July 19, 1952, c. 950, 66 Stat. 798, 35 U. S. C. 112, Section 1 ..... 2, 8, 12
35 U. S. C. 7 ..... 13
35 U. S. C. 120 ..... 4
35 U. S. C. 132 ..... 12

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### OPINIONS BELOW

The original opinion of the Board of Appeals of the United States Patent Office appears at Pet. App., pp. 5a–7a; the opinions of the Board following petitioner's request for reconsideration and further request for reconsideration appear at Pet. App., pp. 8a–9a and at p. 10a, respectively. The memorandum opinion of the district court (Pet. App. 11a–14a) is reported at 116 USPQ 87, and the opinions of the Court of Appeals (Pet. App. 19a–36a) are reported at 116 USPQ 79 and 251 F. 2d 898.

## JURISDICTION

The judgment of the Court of Appeals was entered on January 9, 1958 (R. 404). The petition for a writ of certiorari was filed on April 4, 1958. The jurisdiction of this Court is invoked under 28 U. S. C. 1254 (1).

## QUESTION PRESENTED

Whether a patent application which discloses a broad general chemical formula, from which thousands of compounds may be derived, is sufficient, under the statutory requirements relating to specifications, to support claims to specific compounds.

## STATUTES

Section 1 of the Act of July 19, 1952, c. 950, 66 Stat. 798, 35 U. S. C. 112, provides as follows:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
>
> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and

such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

**STATEMENT**

On March 13, 1951, petitioner Bersworth [1] filed the patent application here in issue, Serial No. 215,380, entitled "Hydroxy Derivatives of Alkylene Polyamines" (R. 203a). This application was stated to be a continuation-in-part of petitioner's prior application, Serial No. 39,377, filed July 17, 1948, which was in turn a continuation-in-part of application Serial No. 657,893, filed March 28, 1946 (R. 205a). The 1946 application, disclosing a chemical formula with lettered substituents, matured into Patent No. 2,524,218 on October 3, 1950 (R. 113a–116a). The examiner, finding that the 1950 patent did not have a disclosure adequate to support the claims sought in the 1951 application, rejected the claims on the ground that they were unpatentable over two prior patents issued to petitioner in 1947, Nos. 2,413,856 and 2,428,353 (R. 222a–223a).

On appeal to the Board of Appeals, petitioner conceded that the 1947 patents disclosed compounds which anticipated the rejected 1951 claims, but disputed the finding as to lack of disclosure in the 1950

[1] The Dow Chemical Company, also a petitioner, was added as a party plaintiff by order of the district court pursuant to a stipulation of the parties (R. 5a–7a) after the company had acquired all of Bersworth's rights to the patent application here involved. References in this brief to "petitioner" are to Bersworth.

patent (Pet. App. 6a–7a). Relying upon the doctrine of continuity,[2] petitioner contended that the disclosure of the 1950 patent was sufficient to entitle the 1951 application to the benefit of the 1946 filing date of the 1950 patent, and that the rejected application was therefore copending with the 1947 patents relied upon to defeat his claims (*ibid.*). The Board, while noting that the specific chemical compounds claimed in the 1951 application would be reproduced "[b]y selecting certain values and substituents within" the formula disclosed in the 1946 application, held that the 1946 application "does not specifically disclose any of the compounds now claimed" and accordingly does not support such claims (Pet. App. 7a), as required for continuity. The Board accordingly affirmed the examiner's decision (*ibid.*).

In a second decision (Pet. App. 8a–9a), rendered on petitioner's request for reconsideration, the Board, confirming its earlier ruling, specifically rejected petitioner's contention that the affidavits offered demonstrated that "with the broad formula of this [1950] patent before him and the possible substituents named one would be *compelled* to arrive at the compound now claimed" (Pet. App. 8a; emphasis in the original). A further request for reconsideration was rejected as out of time (Pet. App. 10a).

Petitioner then instituted this action, seeking a decree declaring that petitioner is entitled to a patent and authorizing the Commissioner to issue such patent (R. 1a–4a). By stipulation, petitioner withdrew from

[2] See 35 U. S. C. 120, Pet. App. 1a.

consideration claims 1 and 3 of the 1951 application, thus limiting the issues to claims 2 and 4 (R. 8a). After hearing testimony of witnesses offered by petitioner to explain and interpret the language of the applications and to show that the compounds defined in claims 2 and 4 were derivable from the general formula disclosed in the prior application (R. 9a–96a), the district court ruled in favor of the petitioner. Findings of Fact (R. 100a–103a), Conclusions of Law (R. 103a–104a), and a memorandum opinion (R. 96a–99a) were entered by the court. The memorandum noted that the sole issue was whether Patent No. 2,524,218 sufficiently disclosed the subject matter of the subsequent application to support continuity (R. 97a; Pet. App. 12a). Petitioners admitted, said the court, that the formula of the patent disclosed "possibly a limitless number of * * * compounds", but argued that this did not preclude a contention "that the applicant had a clear conception of the invention claimed here" (Pet. App. 13a). In sustaining this view, the court ruled that "[t]he testimony of the experts was clear and convincing that the language of the original application, including the chemical symbols, did lead directly to the composition for which the plaintiffs seek a patent monopoly" (R. 99a; Pet. App. 13a).

The Court of Appeals reversed, Judge Danaher dissenting (Pet. App. 19a–36a). In his opinion, Chief Judge Edgerton held that the question presented was one of law and not to be determined by the opinion of experts, since the answer to the question of suffi-

ciency of disclosure turned on the relation between the words of the two applications—words which "always raise a question of law for the court * * *" (Pet. App. 20a–21a). Judge Edgerton held that, as a matter of law, a general disclosure such as that in the 1946 application would not, with respect to specific claims such as those in the subsequent application, meet the statutory specification requirements (Pet. App. 21a).[3] An applicant may not, he said, "preempt the entire field" by a broad formulation which fails to specify, in the manner required by statute, a subsequently claimed invention (Pet. App. 21a–22a). Judge Edgerton added, in a footnote, that if the issue were treated as a question of fact the result would be the same, since the Patent Office finding was not only consistent with all the evidence introduced in the Patent Office proceeding and in the district court but did not conflict with any of the

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[3] The opinion noted earlier (Pet. App. 20a):

"* * * According to undisputed testimony in the District Court, a general formula disclosed by the 1946 application 'encompassed within [its] scope * * * a large number', possibly thousands, of compounds, including the one now specifically claimed; 'a small number of known, but many unknown' compounds; chemists can 'derive' the specific formula now claimed, and many others, from the general formula; 'You derive the compound [now claimed] by assigning certain values to the *m* variables set forth in the general formula' disclosed in 1946, but 'there are many other compounds that would be derived in the same way * * *'. A witness for appellees who testified, on direct examination, that the 1946 'formula, with the explanatory disclosure, specifically dictates the formula' now claimed testified on cross-examination that 'One is led to other compounds as well' and that he 'had a definite goal in mind' when he picked a particular 'substituent'."

evidence; as a result, the district court would be "clearly wrong" in overruling such a finding by the Patent Office (Pet. App. 21a–22a, note 2).

## ARGUMENT

The decision of the court below, reversing the district court and reinstating the finding of the Patent Office, is based upon established principles of patent law and was compelled by the statutory requirements as applied to the particular facts of this case. The principles relied upon are in accord with those applied in other circuits. There is no occasion for further review by this Court.

1. Petitioner's various challenges to the decision below appear to be based upon an erroneous reading of that decision. The Court of Appeals has not, as petitioner apparently assumes, overruled the district court's finding that the broad general formula disclosed in the 1950 patent "did lead directly to the composition" claimed in the 1951 application. To the contrary, the Court of Appeals has accepted that finding. It has ruled, nevertheless, that, as a matter of law, claims to specific compounds are not supported by a description setting forth a broad general formula from which thousands of specific compounds, including those claimed, may be formulated.[4] This is so, said the court, because the statute

[4] Petitioner noted as follows in his brief before the Board of Appeals (R. 230a; emphasis added):

"The Examiner's first ground for rejection raises a *question of law* * * *.

"The *question of law* presented in the first ground for rejection is whether or not an applicant who makes a genus

requires that "[t]he specification shall contain a written description of *the invention*, and of the *manner and process of making* and using it, in such *full, clear, concise, and exact terms* as to enable any person skilled in the art to which it pertains * * * to make and use the same, and shall set forth the *best mode contemplated by the inventor* of carrying out his invention" (35 U. S. C. 112; emphasis added). The court's ruling takes into account the fact that the compounds here claimed are derivable from the broad formula set forth, but in addition takes into account the uncontradicted testimony of petitioner's own witnesses that "many other compounds * * * could be derived in the same way * * *" (R. 38a).[2]

This ruling is, we submit, clearly correct, as is the ruling that the question involved is one of law, not fact. The court below was not called upon to determine whether the specification or description of the 1946 application was sufficient, under the statute, to describe *an invention*, nor was it called upon to determine whether the claims in issue were similarly

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disclosure in a parent application is entitled to the benefit of the filing date of the parent application for priority as to species disclosed and claimed in subsequently filed continuation applications. * * *"

[2] The Government conceded in the court below that "[i]f the invention defined in the claims at issue were the general formula, *i. e.*, the class or genus encompassed within the concept of that formula, * * * the doctrine of continuity would permit [petitioner] to claim the benefit of the filing date of [the 1950 patent]. However, the claims at issue are specific, not broad". Brief for Appellant in No. 13,566, p. 11.

sufficient to describe *an invention.*[6] It has properly ruled that a description which discloses as the invention a generic formula encompassing thousands of specific compounds does not support a claim to the invention of one or more of the thousands of specific compounds thus disclosed.[7] This proposition is not only correct, since clearly the invention claimed in such case is not the invention described, but is in accord with the many decisions, both in the court below and in the Court of Customs and Patent Appeals, which hold that the statutory requirement of disclosure is not met if the result claimed is one of many which might be achieved by following the description

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[6] Indeed, it has been conceded throughout that the claims at issue are patentable if they are supported by the disclosure of the 1950 patent. Although not an issue in this case, it also seems apparent that, in issuing Patent No. 2,524,218, the Patent Office was satisfied that the broad general formula of the 1946 application was sufficient to support a *generic* claim based thereon. That patent contains three claims (R. 116a), of which the first is such a generic claim. The second and third claims are to specific compounds disclosed by the general formula, *as elaborated by the Examples* (R. 113a–116a). In the application here at issue, only the broad formula itself (R. 113a) is relied upon for disclosure (see, *e. g.*, Pet. App. 12a, 32a, note 13), since the compounds claimed in the 1951 application (R. 214a) do not fall within the Examples disclosed in the 1950 patent. Under the doctrine of continuity (see *infra*, pp. 11–13), only those portions of the earlier application which are substantially the same as those in the later application may be relied upon. *Asseff, et al.* v. *Marzall*, 189 F. 2d 660 (C. A. D. C.).

[7] Claim 2, for example, is clearly and expressly limited to two distinct compounds, the diethanol ethylene diamine diacetic acid and the dipropanol ethylene diamine diacetic acid (R. 214a).

set forth. *In re Mraz*, 36 App. D. C. 435; *General Railway Signal Co.* v. *Thullen*, 32 App. D. C. 575; *Application of Pratton*, 40 C. C. P. A. 724, 200 F. 2d 706;[8] *Application of Smyth*, 38 C. C. P. A. 1130, 189 F. 2d 982; *Thompson* v. *Dicke*, 27 C. C. P. A. 931, 110 F. 2d 98; *In re Crowell*, 23 C. C. P. A. 1246, 84 F. 2d 206; *In re Collins*, 22 C. C. P. A. 1053, 75 F. 2d 1000.

Moreover, as shown by the opinion below, a contrary ruling would undermine the rationale of the constitutional provision[9] upon which the patent laws rest (Pet. App. 21a–22a):

> * * * As a matter of law, an applicant cannot "'include and claim a specific thing not originally described, merely because it comes within the scope of the genus before disclosed.'" *In re Mraz*, 36 App. D. C. 435, 438. An applicant "under the circumstances of this case, cannot preempt the entire field * * * by broadly teaching that useful results may be obtained by mixtures and combinations of a broad general group of materials without specifically naming such material * * * or in some other manner pointing out his invention as is required by statute * * *." *In re Collins*, 75 F. 2d 1000, 1002, 25 USPQ 38, 41 (C. C. P. A.).

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[8] "The statutes require more than a statement of a broad field to be usurped to support claims to a composition of matter." 200 F. 2d at 712.

[9] Art. I, Sec. 8, Clause 8: "The Congress shall have Power * * * To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries * * *".

*Minnesota Mining* [*& Mfg. Co.* v. *Carborundum Co.*, 155 F. 2d 746, 69 USPQ 288 (C. A. 3)].

2. The correctness of the decision below, as well as the error in the assumptions of petitioner and of the dissenting opinion,[10] are further demonstrated by a brief résumé of the doctrine of continuity as applicable to this case. That doctrine, originally propounded in *Godfrey* v. *Eames*, 1 Wall. 317, permits a second application to be considered a continuation of a prior application if "a patent is still sought for the substance of the invention as originally claimed * * *" (1 Wall. at 324–325). The doctrine rests upon the concept of "unity of invention" and is applicable only if the disclosures relied upon describe the same invention and are sufficient to support the claims. *Good Roads Co.* v. *Chas. Hvass & Co.*, 70 F. 2d 625 (C. A. 2); *Field* v. *Colman*, 40 App. D. C. 598; *Duryea* v. *Rice*, 28 App. D. C. 423; *In re Febrey*, 30 C. C. P. A. 1099, 135 F. 2d 751. The basic test is whether the claims in the later application could have been properly issued on the description of the original application. *General Electric Co.* v. *Continental Fibre Co.*, 256 Fed. 660, 664 (C. A. 2).[11]

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[10] Judge Danaher, like petitioner, deals only with the question of whether those "skilled in the art" could in fact derive the claimed compounds from the generic formula, which, as he states, is a question of fact. But, as argued above (pp. 7–10), that does not decide the question of law which remains.

[11] It was conceded that petitioner was entitled to designate the 1951 application as a "continuation-in-part" of the 1946 application, since the right so to designate a second application is determined by the disclosure of the two applications, and not by the scope of the *claims* of the later application. *In re Klein*, 1950 Commissioners' Decisions 2.

As we have seen, these requirements have not been met in this case, for there is no unity of invention. Nowhere in the original application are the specific compounds claimed described with the accuracy required by the statute. Without such specific disclosure, the claims at issue could not have been granted on the basis of the description in the original application.[12] Nor can it be said that, lacking express disclosure, there is inherent disclosure in the earlier description. Cf. *Lindley* v. *Shepherd*, 24 F. 2d 606 (C. A. D. C.). The requirement of inherent disclosure cannot be met merely by demonstrating that the disclosure *might* yield the specific thing claimed; the law requires certainty, and the result claimed must necessarily or inevitably happen if the description is followed. *Forward Process Co.* v. *Coe*, 116 F. 2d 946 (C. A. D. C.); *Kropa* v. *Robie, et al.*, 38 C. C. P. A. 858, 187 F. 2d 150; *McCormick* v. *Malherbe*, 28 C. C. P. A. 838, 116 F. 2d 520. If the compounds here claimed are inherently disclosed, within the meaning of the statute, by the specification relied upon, then each and every one of the possible thousands of compounds also derivable are likewise disclosed by the same formula—a result which is surely negatived by the statutory requirement that the inventor "set forth the best mode contemplated * * * of carrying out his invention" (35 U. S. C. 112; cf. *Van der Horst Corp. of America* v. *Chromium Corp. of America*, 98 F. Supp. 412

[12] Any attempt to add the disclosure of these compounds by amendment of the 1946 application would have been barred as new matter under 35 U. S. C. 132.

(S. D. N. Y.)). It is not enough that the specific compounds will, as here, be obtained by particular selections from numerous sets of variables, for the statute plainly does not countenance such speculative disclosure.

3. Petitioner's specific objections to the decision below are not well taken. First, the contention (Pet. 6–7) that the court gave undue weight to the findings of the Patent Office ignores the fact that the court expressly rested its holding upon its determination of a question of law, noting the Patent Office finding only in a footnote dictum.[13]

Petitioner's contention (Pet. 7-8) that the statutory specification requirements are met, as a matter of law, if it can be shown, as a matter of fact, that those "skilled in the art" are apprised of how to produce the invention claimed, and that the court below has erroneously overruled the district court's factual finding in this regard, are merely restatements of the argument that it is sufficient to demonstrate that the specific compounds here claimed are in fact derivable from the generic formula set forth. We have already

[13] Petitioner asserts that the presumption of correctness accorded Patent Office decisions should be discarded because the "ultimate judgment of the Patent Office * * * is that of an individual * * * Examiner, * * * acting on matters before him *ex parte*" (Pet. 6), without sufficient training to acquire the presumed expertise. Here, the Patent Office "judgment" attacked is that of three examiners-in-chief who twice considered petitioner's case (Pet. App. 5a–9a; for the statutory qualification requirements for the position of examiner-in-chief, see 35 U. S. C. 7). These deliberations were, of course, *ex parte* only in the sense that there was no party adverse to petitioner contesting his application.

demonstrated that this proposition is unsound (*supra*, pp. 7–11).

The argument that the decision of the court below is in conflict with its own decision in *Stradar* v. *Watson*, 244 F. 2d 737 (C. A. D. C.), is also without merit. The court there decided the factual question of whether a prior patent anticipated the invention there claimed; it was not faced with the legal question of whether a broad general chemical formula in a specification supports specific claims.

Finally, petitioner's claim that he has been deprived of his property without due process of law is baseless. While letters patent, once issued, are constitutionally protected property, *McCormick Machine Co.* v. *Aultman*, 169 U. S. 606, *Cramp & Sons* v. *Curtis Turbine Co.*, 246 U. S. 28, petitioner never secured letters patent on the claims in issue. Prior to patent, an invention is not property, *Chemical Foundation* v. *General Aniline Works*, 99 F. 2d 276 (C. A. 3), being at most an inchoate right. *Mullins Manufacturing Co.* v. *Booth*, 125 F. 2d 660, 664 (C. A. 6). In any event, the extended administrative and judicial proceedings below can hardly be termed a denial of "due process of law".

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.[14]

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[14] On May 5, 1958, the petitioner in *Petrocarbon Limited* v. *Watson*, No. 711, this Term, certiorari denied, 355 U. S. 955, filed a Motion for Leave to File Petition for Rehearing and Petition for Rehearing, alleging that that case and this one present "substantially the same issues" (p. 1), and requesting that the Court issue writs of certiorari in both cases (p. 7). It is further alleged that the Court of Appeals' decisions in both cases are identical (pp. 3–4) but are in conflict with decisions in the Ninth Circuit and the decision in a later case in the court below (pp. 4–5).

These assertions are without foundation. The issues decided in the cited cases are in no way related to the holding of the court below in this case. In the present case, evidence was introduced to show that the compounds claimed were in fact derivable from the general formula disclosed. The finding based thereon was accepted by the Court of Appeals, but the legal conclusion that this was sufficient to satisfy the statutory specification requirement was rejected, since the evidence also showed that thousands of other compounds were likewise disclosed. In *Petrocarbon*, on the other hand, the court held

that when an application contains no statement, as required by statute, of a "manner * * * of * * * using" the invention, testimony is not admissible to remedy this defect by showing that the invention is in fact useful. In *Interchemical Corporation* v. *Watson*, 251 F. 2d 390 (C. A. D. C.) (p. 5), the question was clearly one of fact, as the court stated: "whether the use of an unmasticated rubbery copolymer was inherent in the applicant's specification. If it was not, then a proffered amendment to describe the rubbery copolymer as unmasticated would be barred as introducing new matter into the claims" (251 F. 2d at 391). The court ruled that expert testimony was properly relied upon in determining this issue. Similarly, in *Moist Cold Refrigerator Co.* v. *Lou Johnson Co., Inc.*, 249 F. 2d 246 (C. A. 9), and the cases cited therein (see the quotation at p. 5 of the Petition for Rehearing), the question was again factual: whether a disclosure was sufficient to enable one skilled in the art to make and use the invention disclosed.

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